

AUG 21 2000

GA 1655

PATENT

#49
B. Webb
9/25/00

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Goelet *et al.*

Examiner: Sisson, B.

Serial No.: 08/971,344

Group Art Unit: 1655

Filed: November 17, 1997

Docket: 13020-2

For: Single Nucleotide Polymorphisms
and Their Use in Genetic Analysis

Dated: July 31, 2000

Kalow & Springut LLP
488 Madison Avenue, 19th Floor
New York, NY 10022

Assistant Commissioner for Patents
Washington, DC 20231

RESPONSE TO RESTRICTION REQUIREMENT

Sir:

In the Office Action dated May 5, 2000, the Examiner has made a restriction requirement, under 35 U.S.C. § 121, dividing the claims into six different groups:

Group I claims 54 and 55;

Group II claims 56-70;

Group III claims 71 and 72; claims 73-81;

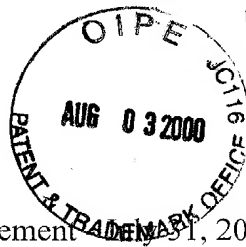
Group IV claims 82; claims 83-86; claims 87-90; claims 91-93; and claims 107-112;

Group V claims 94-98; claims 99-100; claims 101-106, and claims 107-112;

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Group VI claims 113-119; and claims 120-126.

Applicants provisionally elect to prosecute the subject matter of Group V, claims 94-98, claims 99-100, claims 101-106, and claims 107-112, with traverse.

Claims 101-106, although not indicated on the Office Action were inadvertently omitted due to a clerical error, as was discussed with the Examiner in a telephone interview on July 24, 2000. Applicants thank Examiner Sisson for taking the time to discuss this matter.

Applicants maintain the asserted traverse, as it is believed that all of the claims of Groups II through V are related to methods which use Single Nucleotide Polymorphisms in genetic analysis. Group I claims are directed to genetic marker sets comprising single nucleotide polymorphisms. Despite the invention being capable of implementation in a variety of ways, the claims are unified under a common conceptual scheme, and this invention should not be construed too narrowly. The Examiner would, therefore, likely determine it to be necessary to cite a reference related to one group of claims against the other group of claims. Applicants believe that separate searches for each of the defined groups of claims would be substantively duplicative, and that the Examiner has not demonstrated a search directed to all of the claims would present an undue burden. Accordingly, reconsideration of the requirement for restriction is respectfully requested.

Pursuant to a two-month petition for extension of time filed concurrently with this response, the period set for response to this office action expires on August 5, 2000 and this response is therefore timely filed.

In view of the present submission, it is respectfully submitted that this application is in condition for further consideration and examination, and passage to

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allowance as the examination permits. If resolution of any remaining issue is required prior to examination of the application, it is respectfully requested that the Examiner contact Applicants' undersigned attorney at the telephone number provided below.

Respectfully submitted,

A handwritten signature in cursive script that reads "Franklin S. Abrams".

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